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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eric Garland

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2169

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,283	Applicant(s) GARLAND ET AL.	
	Examiner Greta L. Robinson	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16, 24-30 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) 39-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/09, 1/7/09, 6/9/08 & 9/19/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I claims 9-16 and 24-30 in the reply filed on April 03, 2008 is acknowledged.

This application contains claims 39-43 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Claims 9-16, 24-30 and 39-43 are pending. Claims 39-43 have status withdrawn.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on January 9, 2009, January 7, 2009, June 9, 2008 and September 19, 2008 have been considered by the examiner, note attached copies of form PTO-1449. The examiner notes non-patent document Final Office Action cited on form PTO-1449 for application serial no. 11/116466 dated April 27, 2005. The document was not considered because a copy was not submitted.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show intercept concept as as described in the specification at paragraph [0070]. Note flow chart step 1124 Figure 11. Specification states system 992 intercepts inventory from

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network from network 900 at step 1124. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 9-16 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 19 and 24 the limitation "file-sharing or peer-to-peer network" is vague. Claims 10-16 and 25-30 are rejected based on dependency.

8. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Regarding claims 9-16 the concept of *files being copied after interception* is omitted. Note support for this limitation can be found at paragraph [0070], which reads as follows, "Inventory is copied to database 1014 at step 1126". See Figure 11.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claim 24-26 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta et al. US Patent Application Publication No. 2002/0138471 A1.

As per independent claim 24 Dutta teaches:

coupling a computer to a database, the database to store lists of shared files available from peer computers on the file-sharing or peer-to-peer network at fig.4, paragraph 70 and 0066;

coupling the computer to the network to the file-sharing or peer-to-peer network at fig.4, paragraph 70 (client rating database);

locating a plurality of computers connected to the file-sharing or peer-to-peer network by IP address at paragraph 71, lines 4-5;

requesting a listing of an entire library of shared files from each of said plurality of computers connected to the file-sharing or peer-to-peer network at paragraph 59, lines 1-4;

receiving the listing of the entire libraries of shared files from the computer ... automatically storing the listing at paragraph 60, lines 1-4, paragraph 0041 and paragraph 0070 returns requested files in peer node in response to retrieval requests.

As per claim 25, same as claim arguments above and Dutta teaches:

further comprising adding source information to each of the listings at paragraph 71. As

As per claim 26, same as claim arguments above and Dutta teaches:

wherein the source information comprises the geographic location of a computer

where the library is stored at paragraph 71.

As per independent claim 9 Dutta teaches:

a computer coupled to the file-sharing or peer-to-peer network at fig.4, paragraph 70;

a database to store information about files available on the file-sharing or peer-to-peer network coupled to the computer at fig.4, paragraph 0066 ratings module monitors events also see paragraph 70 (client rating database);

a query device adapted to request a list of all shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;

and a transfer device adapted to intercept the list of all shared files from each computer of the plurality of computers and automatically store the list of shared files in the database, thereby tracking file storage on the file-sharing or peer-to-peer network see paragraph 60, lines 1-4, also note *shared file list* 264 paragraph 0041, paragraph 0066, 0059 obtains copy and stores in database; paragraph 0064 software component may be extendable API and paragraph 0065 plug-in routines may be implemented to coordinate routines and retrieve dynamically.

With respect to claim 10, same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

As per claim 11, same as claim arguments above and Dutta teaches:

further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of lists at paragraph 71(client ratings database).

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As per claim 12, same as claim arguments above and Dutta teaches:

further comprising an inventory processing server coupled to the database at paragraph 71.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further

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comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

14. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 29-30 same as claim arguments above, however Dutta do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

Response to Arguments

15. Applicant's arguments filed September 21, 2007 have been considered but they are not persuasive. Applicant's arguments with respect to claims 9-16 and 24-30 have been considered but are moot in view of the new ground(s) of rejection.

In the response Applicant argued the claims have been amended to overcome the rejections. Specifically claims 9 and 24 have been amended to specify the database is to store lists of shared files available from peer computers on a peer-to-peer network and that the claimed system or method receives the list of shared files. In response to applicants amendment rejections under 35 USC 101, 35 USC 112 first and second paragraphs are withdrawn. However, a new rejection under 35 USC 112 second paragraph is cited. The examiner respectfully maintains the prior art rejection. With respect to claims 24-26, Applicant argues Dutta's method operates on information about files that are actually retrieved, while the present inventions method collects information about files that may never be retrieved. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., method collects information about files that may never be retrieved) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As presently written independent claim 24 appears to receive information note claim 24 line 10 "receiving the listing of the entire library of shared files". This limitation appears to contradict argument. Dutta provides for the ability to receive an entire library of shared files [see: paragraphs 006-007 and 070 distributed file-sharing system supports peer-to-peer model for exchanging data. Each node has a list of addresses that can directly communicate with each other. Each peer node searches its own database to

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satisfy the query. Copies the query to each node in its list of peer nodes. Dutta teaches an alternative (264) list of shared files which may be imported and exported see paragraph 0041 and Figure 2C sharable file list element 264. O'Kane teaches devices in a file sharing environment for tracking and regulating process see paragraph 0062-0063. Regarding independent claim 9, Applicant argues prior art reference Nair does not teach a transfer device adapted to intercept the list of shared files.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571)272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/
Primary Examiner, Art Unit 2169
March 13, 2009